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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,584	06/19/2003	Robert W. Blakesley	45858/55670-DIV	5497
21874	7590	05/31/2006	EXAMINER	
EDWARDS & ANGELL, LLP			BRUSCA, JOHN S	
P.O. BOX 55874			ART UNIT	
BOSTON, MA 02205			PAPER NUMBER	
			1631	

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/600,584

**Applicant(s)**

BLAKESLEY ET AL.

**Examiner**

John S. Brusca

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2006 and 12 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 26-39 is/are pending in the application.
- 4a) Of the above claim(s) 29-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-28 and 33-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/17/2003</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. It is brought to the applicant's attention that no power of attorney has been filed in the instant application.
2. The applicants filed a request for a corrected filing receipt on 17 November 2003 regarding the assignment for the instant application. It is not apparent from the application file that the correction has been made. The assignment of parent Application No. 09/354664, now U.S. Patent No. 6,750,059, will ordinarily transfer to this divisional application, as noted in MPEP 306:

**306 [R-3] Assignment of Division, Continuation, Substitute, and Continuation-in-Part in Relation to Parent Application**

In the case of a division or continuation application, a prior assignment recorded against the original application is applied >(effective)< to the division or continuation application because the assignment recorded against the original application gives the assignee rights to the subject matter common to both applications. >Although the assignment recorded against an original application is applied to the division or continuation application, the Office's assignment records will only reflect an assignment of a division or continuation application (or any other application) if a request for recordation in compliance with 37 CFR 3.28, accompanied by the required fee (37 CFR 3.41), is filed.< In the case of a substitute or continuation-in-part application, a prior assignment of the original application is not applied >(effective)< to the substitute or continuation-in-part application because the assignment recorded against the original application gives the assignee rights to only the subject matter common to both applications. Substitute or continuation-in-part applications require >the recordation of< a new assignment if they are to be issued to an assignee. >See 37 CFR 3.81.<

The applicants may wish to contact the Assignment Branch by email at [AOTW@uspto.gov](mailto:AOTW@uspto.gov), or by phone at (571)272-3350.

***Election/Restrictions***

3. Applicant's election with traverse of Group 1 and the host cell species in the replies filed on 14 March 2006 and 12 April 2006 is acknowledged. The traversal is on the ground(s) that:

1) The applicants state that a search burden does not exist to examine Groups 1 and 2, however the claims are drawn to different methods, with Group 1 drawn to a method of isolation of a vector, and Group 2 drawn to a method of manipulation of vectors. The search for the two groups would not be coextensive even though there might be some overlap of the claimed subject matter. In addition the applicants appear to ask what other method could be used to make the product produced in the method of Group 2 than the method of Group 1? Since both groups are methods, the criteria for distinctness is not that of a product and method of making, but rather that of distinctness between two methods. The method of Group 2 does not include the steps of isolation of Group 1 and contains alternative steps of manipulation of the vector. Therefore the two groups do not overlap and are drawn to different methods. The applicants further state that the species requirement is improper because there is no search burden to search all species and the phrase "and combinations thereof" should block a species election requirement. Each of the species of sample is mutually exclusive and further requires a different search due to the differences in the structures of each species of sample. The "combinations thereof" limitation merely defines additional species of sample that are combinations of components.

The requirement is still deemed proper and is therefore made FINAL.

4. Claims 29-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

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Applicant timely traversed the restriction (election) requirement in the replies filed on 14 March 2006 and 12 April 2006

### *Drawings*

5. The applicants filed drawings at the time of filing on 19 June 2003 and a second set of drawings on 17 November 2003. The black and white drawings filed on 17 November 2003 are acceptable. On 17 November 2003 an artifact file was created in the application file that apparently contains color drawings or photographs. The artifact file cannot be located at the time of preparation of this Office action. If the applicants intend to add color drawings to the application file the requirements detailed below must be met.

6. Color photographs and color drawings are not accepted unless a petition filed under 37 CFR 1.84(a)(2) is granted. Any such petition must be accompanied by the appropriate fee set forth in 37 CFR 1.17(h), three sets of color drawings or color photographs, as appropriate, and, unless already present, an amendment to include the following language as the first paragraph of the brief description of the drawings section of the specification:

The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.

Color photographs will be accepted if the conditions for accepting color drawings and black and white photographs have been satisfied. See 37 CFR 1.84(b)(2).

### *Specification*

7. The application is objected to because of alterations which have not been initialed and/or dated as is required by 37 CFR 1.52(c). A properly executed oath or declaration which complies with 37 CFR 1.67(a) and identifies the application by application number and filing date is required.

An alteration appears on page 16, line 13 that is not initialed and/or dated.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 26-28 and 33-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers et al. (cited in the Information Disclosure Statement filed 17 November 2003) in view of Burgoyne (U.S. Patent No. 5,496,562 cited as reference AB in the Information Disclosure Statement filed 17 November 2003) in view of Kahn et al.

The claims are drawn to a method of isolation of vectors from host cells by contacting the host cells with a solid medium. In some embodiments the solid medium protects the vector from degradation, is made of cellulose or a micromesh plastic, the host cells are in solution, and the solid medium comprises urate salt, a chelating agent, and an anionic detergent.

Rogers et al. shows in the abstract and throughout recovery of DNA from bacterial liquid cultures by application of the bacterial culture to FTA blood storage medium. Figures 1 and 2 show positive results of PCR assay of bacterial DNA from FTA media to which bacterial cultures were applied. Rogers et al. shows that the DNA is stable for at least 1.6 years after application to the FTA media on page 226. Rogers et al. does not show use of bacteria comprising vectors, media comprising micromesh plastic, and Rogers et al. does not detail the composition of the chemicals in the FTA media. Rogers et al. states on page 223 that FTA medium is described in Burgoyne (U.S. Patent No. 5,496,562).

Burgoyne shows the components of a solid medium for preserving DNA in columns 2-4, including use of a solid support such as cellulose or a micromesh of a synthetic plastic (column 2, lines 21-23), urate, an anionic detergent, and a chelating agent (column 2, lines 54-64 and column 3, lines 18-26). Burgoyne shows storage of plasmids on the solid medium in column 4, line 61.

Kahn et al. reviews plasmid cloning vectors, and shows that such vectors are replicated in bacteria in the abstract and throughout. Kahn et al. shows on page 268 that plasmid vectors are useful for cloning and maintenance of foreign DNA.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the method of Rogers et al. by use of bacteria comprising vectors because Burgoyne shows that the solid media used by Rogers et al. can be used for long term storage of plasmids, and Kahn et al. shows that bacterial plasmid vectors are useful for cloning and maintenance of foreign DNA.

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***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Brusca whose telephone number is 571 272-0714. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 571 272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*John S. Brusca 25 May 2006*

John S. Brusca  
Primary Examiner  
Art Unit 1631

jsb